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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,633	02/27/2004	Jon Washington	D-1213	1328
28995	7590	03/10/2006	EXAMINER PAIK, STEVE S	
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			ART UNIT 2876	
PAPER NUMBER				

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/790,633

Applicant(s)

WASHINGTON ET AL.

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 46-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 64 and 65 is/are rejected.
- 7) ☒ Claim(s) 45-63, 66-70 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/30/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 2876

## **DETAILED ACTION**

### ***Response to Amendment***

1. Receipt is acknowledged of the Pre-Amendment filed February 27, 2004.

### ***Specification***

2. The abstract of the disclosure is objected to because the abstract does not provide a concise statement of the technical disclosure of claimed invention. It appears that it is identical to the Abstract of its parent application. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

Art Unit: 2876

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1, 64, and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peebles et al. (US 6,454,163B2) in view of Calder et al. (US 6,516,998B2).

Re claims 1 and 64, Peebles et al disclose an ATM with an escrow unit (24), reject bin 18 and other storage bins 16. The ATM uses a media entry/exit slot 12 to receive and dispense media. There are two separate media flow path paths for separating returned media from accepted media. The escrow unit functions as a separator for storing media in accordance with validation process. The reject bin 18 stores returned media for later verification.

However, Peebles et al. do not specifically disclose the ATM presenting media having an acceptable media condition to a customer.

Calder et al. disclose a self-service terminal (SST such as an automated teller machine) in Fig. 1. The SST 10 includes a fascia 12, which is accessible by a user, in which is set a media port 14 through which banknotes are dispensed to the user. Inside the SST 10 are located four media dispense modules 16, each of which contains a different denomination of banknotes, and a media purge bin 18, for receiving banknotes which cannot be dispensed (for example, if multiple notes are picked from a module in error). Mounted on a pair of vertical tracks 20 and driven by motors (not shown) between the modules 16 and the SST fascia 12 is a movable media transport 22. The purge bin stores media from cancelled transactions or if the user fails to take their presented bank notes. The process of storing media from cancelled transactions or untaken by a

Art Unit: 2876

customer after a predetermined time would enhance the accurate inventory of media stored in the ATM.

In view of Calder et al.'s teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ the retracting element and step of a currency cassette used in an ATM in addition to the ATM of Peebles et al. due to the fact that accurate inventory of media stored in the ATM can be achieved for the purposes of minimizing loss of media having acceptable condition.

Re claim 65, Peebles et al. in view of Calder et al. disclose the apparatus as recited in rejected claim 64 stated above, wherein diverting media having an acceptable media condition to the diverted media storage area (reject bin 18 of Peebles et al.) includes storing the diverted media in the diverted media storage area without presenting the diverted media to a customer (col. 5, ll. 23-30).

***Allowable Subject Matter***

6. Claims 45-63 and 66-70 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior art of the references discloses, teaches, or fairly teaches the claimed apparatus and method recited in dependent claims 46-63 and 66-70. The reject bin lacks a pivotable partition to direct media to either of the diverted media storage area or the retracted media storage area.

Art Unit: 2876

***Conclusion***


8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Milne (US 6,073,837) discloses an ATM that comprises a mechanism to retract a stack of currency that has been presented to a user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 5:30a-2:00p (Maxi-Flex\*).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Steven S. Paik  
Primary Examiner  
Art Unit 2876

ssp